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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/553,517 | 10/14/2005 | Masayuki Yoshida | 279690US2PCT | 1618 |

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
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ALEXANDRIA, VA 22314

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| EXAMINER |
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TRINH, MICHAEL MANH

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| ART UNIT | PAPER NUMBER |
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2822

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| NOTIFICATION DATE | DELIVERY MODE |
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09/09/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/553,517 | Applicant(s) YOSHIDA ET AL. | |
| | Examiner Michael Trinh | Art Unit 2822 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 5-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2822

DETAILED ACTION

*** This office action is in response to Applicant's election filed May 16 2008. Claims 1-7 are pending, in which claims 5-7 are non-elected without traverse.

Election/Restrictions

1. Claims 5-7 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in Paper mail date May 16, 2008.

Claim Objection

2. Claims 1-4 are objected to as the claim language are vague and confusing for depositing a photosensitive substance of which an exposed portion is removed by a developer, and executing a process for development-removing the pattern, wherein meaning of "desired electrical characteristic" is unclear. Re claim 4, "a step of depositing a photosensitive substance, having a desired electrical characteristic,..." is confusing since it is unclear how the photosensitive substance having the desired electrical characteristic.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

Art Unit: 2822

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al (2003/0038372) taken with Traskos et al (5,309,629).

Re claim 1, Sasaki teaches a method of forming an sheet used as each layer when forming a laminated type electronic part, comprising: step of depositing a photosensitive substance 12,25 (Figs 2-12; paragraphs 49-58) of which an exposed portion is removed by a developer up to a predetermined thickness onto a support body 11 (Fig 2; paragraph 47,9-10); a step of executing an exposure process for forming a predetermined pattern upon the photosensitive substance, executing a process for development-removing the pattern subjected to the exposure process by use of the developer, executing a process of depositing a substance 1a,2a,2 having a desired electrical characteristic onto the portion with the photosensitive substance removed (Figs 3-11; paragraphs 49,52-58), and forming said sheet or part of said sheet on said support body 11 (Figs 11). Re claim 2, wherein said step consisting of the exposure process, the developing process and the depositing process is repeated plural number of times (Figs 2-11; paragraphs 54,61). Re claim 3, wherein said step consisting of the exposure process, the developing process and the depositing process includes a process of depositing the photosensitive substance 12,24 in place of the substance having the desired electrical characteristic 1a,2a,2 (Figs 2-36-11; paragraphs 49-58). Re claim 4, further comprising: a step of depositing a photosensitive substance 12,24, having a desired electrical characteristic 1a,2a,2, of which an unexposed portion is removed by the developer; and a step consisting of a process of forming a further pattern space by exposing and developing the photosensitive substance having the desired electrical characteristic 2a,2, and a process of depositing the substance having the desired electrical characteristic or a further photosensitive substance 24 into the pattern space (Figs 6-11; paragraphs 51-55; Figs 2-5).

Re claim 1, Sasaki lacks removing said support body from said sheet.

However, Traskos teaches, after forming a sheet having an electronic part with a desired

Art Unit: 2822

electrical characteristic on a support mandrel body 12 (Figs 1-4, col 8, line 42 to col 9), removing the support mandrel body 12 from the sheet (Fig 5, col 9, lines 1-8).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form the an sheet used as each layer when forming a laminated type electronic part of Sasaki by removing the support mandrel body from the sheet as taught by Traskos. This is because of the desirability to form a thinner sheet having an electronic part with a desired electrical characteristic thereon, thereby allowing to form very thin electronic devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael M. Trinh whose telephone number is (571) 272-1847. The examiner can normally be reached on M-F: 9:00 Am to 5:30 Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zandra Smith can be reached on (571) 272-2429. The fax phone number is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Oacs-17

/Michael Trinh/
Primary Examiner, Art Unit 2822